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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,289	10/30/2000	Takazaki Inoue	001448	4397

38834 7590 03/24/2005

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EXAMINER

WARDEN, JILL ALICE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/698,289

Applicant(s)

INOUE ET AL.

Examiner

Jill A. Warden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 1-2, 4 and 5 are drawn to an automatic synthesis machine, but only the display device and a selection control device are recited in the claims. Applicants must set forth the structure of the synthesis machine, i.e. reaction vessels, etc., and how they inter-relate structurally and/or functionally with the display and control devices.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed in the United States only if the international application was published under Article 21(2) of such treaty

Claims 1-7 are rejected under 35 U.S.C. 102(e) Inoue, U.S. patent 6,740,296.

The applied reference has a common assignee application. Based upon the earlier effective U.S. filing

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constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Inoue teaches an automated chemical synthesizer similar to that claimed in this application. The synthesizer includes parallel reaction vessels, a display device for displaying certain information about the synthesizer and a selection means for selecting one or more of the parallel reaction vessels displayed on the display device. Inoue teaches that synthesizing protocols are stored in a memory device and retrieved for display and selection for the operator (see column 5-6, lines 65, et seq.) The reagent types and amounts are also stored in memory and displayed on the screen when needed (column 6, lines 42-50). The synthesizer of Inoue also allows an operator to create synthesis protocols which are stored in memory for later retrieval and execution.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (USP 6,489,168 B1).

Wang et al. teach an analysis and control system comprising a monitor 150 for displaying vessels 210 housed in a reaction block 110 and a selection means 600, 680 for selecting one or more vessels displayed on the screen based on data provided by the user 170/150 or storage means 180, such that the selector can modify the operation parameters (e.g. temperature, pH, etc.) related

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to the selected vessels (column 12, lines 46-52, Figs. 6a-6b). Moreover, Wang et al. teach a protocol creation means 700 for creating a protocol based on data supplied from the selector and displaying the vessels together with operation contents of the vessels (Figs. 7a-8, claim 3). Additionally, Wang et al. teach an analysis means 145 or protocol line analysis means for picking out the operation contents supplied by the user/storage and creating the operational procedure related to the selected vessel (Figs. 1,3).

Wang, et al. do not specifically teach that the display device displays protocols including reagent type and operation type.

Wang, et al. does, however, teach that the display device displays measured as well as calculated parameters related to the individual reaction vessels. In column 6, line 29, et seq. teach:

“Data analysis module performs appropriate calculations on the sampled data . . . Reactor control system 100 can also determine whether the reaction occurring in one or more of reactor vessels 210 has reached a specified conversion target based on results calculated in step 360; in that case, reactor control system 100 causes the addition of a quenching agent to the relevant reactor vessel or vessels as discussed above, terminating the reaction in that vessel.”

Control systems are known to provide alarms and indicators of specified conditions. It would have been obvious to one of ordinary skill in the art to display such information as a quenching process for the reaction, as well as the quenching agent employed on the same display device used to monitor reactor contents in order to provide a single point of information, remote from the actual reactor, for the operator to consult.

### ***Response to Arguments***

Applicant's arguments filed December 20, 2004 have been fully considered but they are not persuasive.

With respect to the 112, 2<sup>nd</sup> paragraph rejection, applicant argues that because the reagent type and operation type are used in an automatic synthesis machine, then the claim is clear. Examiner disagrees. If the claim recites an automatic synthesis machine, then sufficient structure of such a machine need be set forth.

Applicant argues that Inoue does not teach selecting vessels from a screen of a display device displaying one or more vessels. Applicant argues that the vessels in Inoue are selected based on dispensing procedure. Examiner would note that the claims specify that vessels are selected, not how they are selected. Examiner also would note that Inoue displays the vessels. If an operator selects all the vessels, he has fulfilled the requirements of the claims.

With respect to Wang, applicant further argues that Wang does not select more than one vessel and displays those vessels differentially. Examiner again would point out that the claim allows for selection of all vessels. No differentiation is required if all vessels are selected. Applicant's claims must specify selection of a subset of the whole (assuming the specification provides basis for such) in order for the selection means and the differential display to have any weight in the claim.

### ***Conclusion***

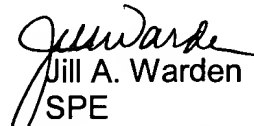
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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill A. Warden whose telephone number is (571) 272-1267. The examiner can normally be reached on Mondays-Thursdays from 5:30 AM to 2:00 PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jill A. Warden  
SPE  
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